

REMARKS

The last Office Action has been carefully considered.

It is noted that Claims 21-24, 26-29, 31, 33, 34, 37 and 38 are rejected under 35 USC 102(b) over the U.S. patent application publication to Kurz.

Claim 25 is rejected under 35 USC 103(a) over the U.S. patent application publication to Kurz in view of the U.S. patent to Kurz.

Claim 30 is rejected under 35 USC 103(a) over the U.S. patent application publication to Kurz in view of the U.S. patent application publication to Knox et al.

Claims 35 and 36 are rejected under 35 USC 103 over the U.S. patent application to Kurz in view of the U.S. patent to Hurst.

Also, the drawings and the claims are objected to and rejected for formal reasons.

In connection with the Examiner's formal objections to the drawings and the claims, the drawings and the claims have been amended correspondingly. It is believed that the grounds for these objections are no longer tenable and should be withdrawn.

As for the Examiner's rejection of Claim 33 under 35 USC 112, the Examiner stated that the subject matter of the claim did not comply with the enablement requirement. He also cast doubt on the ability of a person skilled in the art of otology to understand the quite clear teachings of said Claim 33 to provide *"a device for changing a point of attachment of said prosthesis element on an element"* of the ossicular chain, namely on the hammer, the anvil projection, the stapes or at the inner ear.

Contrary to the Examiner's opinion Figures 3 and 6 clearly exhibit to anyone – skilled in the art or not – a "first clip" named 11, 11', 11", 31 or 31' which can obviously be attached on varying points of the anvil projection 20 or the hammer grip 24. Same applied to the "third clip" 27, which may obviously be attached on varying points of the stapes 28. It is believed that it should not stretch imagination to picture situations where said clips are attached to other points of the respective element of the ossicular chain. Perhaps the Examiner's view in this connection might to arise from a partly inaccurate interpretation of the present invention.

The crucial questions seems again to be how clever an “average person skilled in the art in accordance with the U.S. patent practice must be to comprehend the teaching of the present claim 33 and to practically implement it by accordingly modifying an ossicle prosthesis in line with the teachings of the present claim 21 such as to be in compliance with the further teachings of claim 33. It should be mentioned that the Examiner of the European Patent Office in charge of the parallel case seemed to deem such specialists in the art bright enough to understand the present invention and hence granted the European Patent EP 1 706 071 B1 without any amendments to claim 11 corresponding to present claim 33. It is respectfully presumed that skilled persons in the art in the USA are in no way less brainy and hence would not find any enablement problems with present claim 33.

It is therefore believed that the rejection of claim 33 based on 35 USC 112 should be considered as no longer tenable and should be withdrawn.

After carefully considering the Examiner’s grounds for rejection of the claims over the art, applicants amended Claim 21 by excluding from it some limitations which seemed not to be absolutely necessary. It is believed that Claim 21 clearly and patentably distinguishes the present invention from the prior art applied against the original claims.

The Examiner's rejection of claim 21 in paragraphs 5 and 6 of the outstanding Office Action based on 35 USC 102(b) alleges that Kurz (US 2002/0045939 A1) is anticipating the teachings of claim 21. This is not so and seems to be partly based on the Examiner's misinterpretation of the teachings disclosed in Kurz.

It is respectfully submitted that amended claim 1 is clearly novel over Kurz, because Kurz never teaches any *"means for frequency adjustment"* whatsoever. The "shaft" 14; 32; 52 and 62, 63 in the Kurz device is only disclosed to connect one end of the prosthesis with its opposite end and to provide for a certain flexibility of the prosthesis. No more and no less. In any case, there is no hint, suggestion or motivation about "frequency adjustment," which is, however, the gist of the present invention. In the Kurz device the "frequency transmission" of the described prosthesis is "just as it is" and stays so without any intention to and means for performing any kind of "frequency adjustment).

Further, Kurz does certainly not disclose any *"lever elements for changing lever conditions in the auditory ossicle chain"* being part of above discussed *"means for frequency adjustment"*. As figures 1, 3 and 5 clearly demonstrate, the Kurz device does very well with a one-piece shaft. So, the two-

piece shafts in figures 2, 4 and 6 by no means disclose anything like “lever elements,” but are merely “one-piece shafts interrupted by a spherical joint 23, 42, 64” in order to obtain some “flexibility.” There is no hint in Kurz to disclose, that those two parts of the shaft are configured to act as “lever elements” within the technical meaning of claim 21.

Even less are those two-piece shafts in the Kurz device disclosed to be “*changeable in dependence on a predetermined frequency response*”, which may – according to the present invention – be achieved by “*changing the effective length or lever conditions*”.

It is believed to be clear that the U.S. patent application publication to Kurz does not disclose the new features of the present invention defined in amended claim 21.

As for the Examiner’s rejection of original claim 21 over this reference, it is believed to be advisable to cite the decision In Re Lindenmann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

Definitely, the U.S. patent application publication to Kurz does not disclose each and every element of the present invention as now defined in the amended claim 21.

It is therefore respectfully submitted that claim 21 should be considered as patentably distinguishing over this reference and should be allowed.

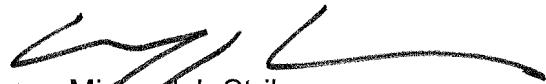
The Examiner's attention is further respectfully directed to claim 39 which in combination with the amended claim 21 substantially corresponds to the scope of the original claim 21. It is respectfully submitted that the new features of the present invention which are defined in claim 39 are also not disclosed in the U.S. patent application publication to Kurz and therefore claim 39 should be allowed as well.

As for the Examiner's rejection of the dependent claims, these claims depend on claims 21 and 39 correspondingly, they share their allowable features, and they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Any costs involved should be charged to the deposit account of the undersigned (No. 19-4675). Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael J. Striker', with a long horizontal flourish extending to the right.

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